

REMARKS

Applicant has reviewed the Final Office Action of April 3, 2007. No claims have been amended. New claims 43-51 are presented. Claims 34-51 will be pending upon entry of this Amendment. Reconsideration is requested.

The Examiner rejected the claims under 35 U.S.C. 112, first paragraph, as allegedly failing the enablement requirement. Applicants traverse the rejection.

The Examiner stated that the claims covered the control of "any and all insects" while the specification discussed only Darkling beetles. In the interest of expediting prosecution, Applicant has added new claims 43-51, which specifically recite that Darkling beetles are controlled, not all insects. The scope of these claims does not appear to be in question.

The Examiner stated that the full scope of the claims ("insects") was not enabled because one of ordinary skill in the art would have to engage in undue experimentation with no assurance of success. To clarify the following remarks, Applicant notes that these remarks are primarily addressed towards claims 34-42, though they do apply to new claims 43-51. The test of enablement is whether experimentation is undue. MPEP § 2164.01; *Mineral Separation v. Hyde*, 242 U.S. 261 (1916); *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). The phrase "with no assurance of success" is not an additional element of the test. Some experimentation may fail, and the word "undue" acknowledges that fact.

The Examiner first stated that there is no evidence that application of trichloromelamine will control insects. The Examiner appears to mean that there are no working examples of Darkling beetles being controlled. Applicant agrees that there is not a working example. However, this factor by itself will not render the claims non-enabled. MPEP § 2164.02.

The Examiner stated that not all insects have pH-dependent life cycles. However, as the Examiner implicitly recognizes, and as stated in the specification, certain insects do have life cycles where the pH of the environment affects their formation and growth. One of skill in the art would be able to identify which insects are affected by pH. Thus, controlling more insects than only Darkling beetles is enabled.

The Examiner also stated that lowering the pH of an animal habitat will not predictably result in control of any and all insects as contemplated by the claims. In response, Applicant submits that § 112, first paragraph, does not require the Applicant to list every insect that can be controlled in order to satisfy either the written description or the enablement requirement. MPEP §§ 2164.02 and 2164.03 explicitly state that Applicant “need not describe all actual embodiments to provide an enabling disclosure” and “even in unpredictable arts, a disclosure of every operable species is not required.” The scope of the claims is enabled if the insects that can be controlled can be identified without undue experimentation, and one example can be enough to do so. Applicant submits that such insects can be identified by one of skill in the art based on the disclosure in the specification regarding pH and the portion of the life cycle (i.e. during formation and growth, rather than after maturity). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991). That Applicant has done so in this case cannot count against him.

The Examiner stated that Applicant has proved no guidance or direction on how one skilled in the art would lower the pH of an animal habitat. This statement is incorrect: Applicant has provided at least two means of how to lower the pH: (1) by dusting with a powder and (2) spraying an aqueous solution. Additionally, one skilled in the art would know how to lower the pH. While it is true that the amount of trichloromelamine which would need to be applied to lower the pH below 5 might vary (e.g., based on the starting pH), the specification discloses various amounts to use, both in weight (see Table 1) and in concentration (about 50 to about 500 ppm). Thus, Applicant has provided direction and guidance as to how to make and use the claims.

The Examiner later stated that minimal guidance had been provided. The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability of the art. MPEP § 2164.03. Applicant submits that the amount of knowledge in the prior art is such that minimal guidance is needed on how to make and use the trichloromelamine. The amount of knowledge in the prior art is also such that the guidance and direction given to identify susceptible insects is sufficient. It is well-known to use pesticides to attack insects at various points in their life cycle as determined by various factors, one of which is pH. The

life cycle of several insects is known and thus it can be predicted which insects are susceptible to control by manipulation of pH. "If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art." MPEP § 2164.03. The combination of the amount of knowledge and the predictability lean towards enablement.

The Examiner stated that it was not predictable that simply applying trichloromelamine would effectively lower the pH of an animal habitat because it might lower the pH of surfaces, but not the surrounding air and habitat. In response, Applicant notes that pH, as a unit of measurement, is not commonly applied to air. However, spraying with an aqueous solution would also lower the pH of the air when the droplets remain volatilized. The pH of the habitat is lowered when the pH of the surfaces that make up the habitat are lowered. Thus, it is predictable that the pH of an animal habitat will be lowered when trichloromelamine is applied. To the extent the Examiner's statement suggests that pH is not predictable, Applicant rebuts this suggestion and submits that the predictability of the art leans towards enablement.

For at least these reasons, Applicant submits the instant claims are enabled under the *Wands* factors. Applicant requests withdrawal of the enablement rejection.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 34-51) are now in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 06-0308.

Respectfully submitted,

FAY SHARPE LLP

July 3, 2007

Date



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I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being	
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Signature: <u>Laurie A. Boylan</u>	
Date: <u>July 3, 2007</u>	Name: Laurie A. Boylan